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30074 7590 12/09/2008 TAFT, STETTINIUS & HOLLISTER LLP SUITE 1800 425 WALNUT STREET CINCINNATI, OH 45202-3957			EXAMINER BEKERMANN, MICHAEL	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/945,378  
Filing Date: August 31, 2001  
Appellant(s): GRAHAM ET AL.

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David A. Mancino  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/5/2007 appealing from the Office action mailed 9/6/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

**NEW GROUND(S) OF REJECTION**

Claims 33-49, 64-66 and 67-70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6764395	GUYETT	7-2004
20030191690	MCINTYRE	10-2003
5679075	FORREST	10-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 33-37, 42, 44-49 and 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyett (U.S. Patent No. 6,764,395) in view of McIntyre (U.S. Pub No. 2003/0191690).**

**Regarding claims 33, 42 and 64-70,** Guyett teaches providing an interactive advertising message (game or puzzle containing a question) to a consumer (Column 2, Lines 39-46) and gathering data associated with the consumer's interactions with the message (Column 10, Lines 17-20). Guyett doesn't specify generating a statistical report and sending it to the commercial entity. McIntyre teaches a statistical report that keeps track of how many times a game is played and the sending of this report to sponsors of the game (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a report to the commercial entity. This would aid the commercial entity in knowing how well-received their game is. Regarding claims 64-66 and 68-70, which introduce the specific data content of the statistical report, it could be argued that Guyett and McIntyre do not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or

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structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of data content. Such data content does not functionally relate to the steps and the subjective interpretation

**Regarding claims 34, and 35**, Guyett teaches the game as being provided on a computer over the Internet (Column 5, Lines 44-52).

**Regarding claims 36, and 37**, Guyett teaches the playing of a series of games (Column 7, Lines 5-8). Guyett teaches selecting the plurality of games based on demographics (Column 6, Lines 40-42). This reads on providing the next of the plurality based on demographics.

**Regarding claims 44 and 46-49**, Guyett teaches monitoring player behavior and recording this into a database in connection with advertisements (Column 6, Lines 19-22). Guyett doesn't specify that the game gathers data related to brand type, taglines, product benefits, imagery, and communication language in particular. Official notice is taken that it is old and well-known that advertisements frequently contain brand type, taglines, product benefits, imagery, and communication language. It would have been obvious to one having ordinary skill in the art at the time the invention was made to gather information related not only to advertisements in general, but also related to the above categories. This would allow the advertiser to understand more about how their product is doing in the marketplace.

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**Regarding claim 45**, Guyett teaches gathering data (player history) related to a commercial entity's products (Column 1, Lines 25-27).

**Claims 38-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyett (U.S. Patent No. 6,764,395) in view of McIntyre (U.S. Pub No. 2003/0191690), and further in view of Forrest (U.S. Patent No. 5,679,075).**

**Regarding claims 38-41, and 43**, Guyett teaches recording the performance history of a player (Column 10, Lines 13-16). Guyett also teaches a plurality of puzzles, but doesn't teach the providing of a next of the plurality of puzzles based on consumer performance. Forrest teaches an interactive multimedia game using multiple puzzles that gives the user a new puzzle based on a satisfactory performance for the previous puzzle (Column 8, Lines 6-9, and Column 8, Lines 18-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a puzzle for the user based on performance of the user. This would give the player a greater sense of satisfaction. Guyett teaches the playing of a series of games (Column 7, Lines 5-8). Guyett teaches selecting the plurality of games based on demographics (Column 6, Lines 40-42). This reads on providing the next of the plurality based on demographics. The puzzles of Guyett are taken to inherently include marketing messages.

### **NEW GROUND(S) OF REJECTION**

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33-49, 64-66 and 67-70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 33-49, 64-66 and 67-70 fail to meet the above requirements.

#### **(10) Response to Argument**

**Response to Appellants arguments of the 103 rejection over claims 33-37, 42, 45, and 67.** Appellant alleges that McIntyre teaches away from the claimed invention by arguing “McIntyre discloses that advertisers are not to be directly contacted, thereby inhibiting receiving any consumer feedback”. The portion of McIntyre to which Appellant refers uses this language “By using a host server 26, the actual sponsor need not ever be actually contacted”. This means that the sponsor does not have to be contacted, as opposed to Appellant’s argument which indicates that advertisers are “not to be” contacted. This argument makes it sound like McIntyre is teaching that a restriction be imposed preventing the advertiser from being contacted, which is not the case.

Regardless of this interpretational issue, this cited portion of McIntyre does not teach away from the claimed invention, and in fact, does not even relate to the portion of McIntyre cited and used in the 103 rejection by Examiner. The portion cited by Appellant relates to inputting predetermined information into the system so the Advertiser does not have to be contacted when decisions are made. This relates to the types of games to which an advertisement is supposed to be supplied. This does not, however, relate to billing. The act of billing inherently comprises providing certain key information to the entity being billed. An act of billing is inherently communication. McIntyre does indeed teach providing a statistical report (bill based on number of advertising views) to a commercial entity.

Applicant continues to argue “Appellant’s claimed statistical report is not the same thing as McIntyre’s bill”. Examiner contends that “statistical report” is a broad term, and since the bill of McIntyre is based on number of times an advertisement is viewed, it is indeed a statistical report.

**Response to Appellants arguments of the 103 rejection over claims 44 and 46-49.**

While the Appellant agrees that Examiner’s taking of Official Notice is correct (that brand type, tag lines, product benefits, imagery, and communication language are all commonly found in advertisements), Appellant argues “just because such categories of data may be present in particular forms of advertisements, it does not follow that there exists any disclosure in either Guyett or McIntyre to gather or process such data”. Examiner contends that if there was disclosure for the exact word-for-word process claimed by Appellant, then this would be a 102 rejection. Examiner has instead, stated that, based on the teachings of Guyett, it would be obvious to test for the above types of data. Guyett teaches testing consumers about products



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seen in advertisements, and as such, it would be obvious to test and store results on all the other aspects of an advertisement. Appellant argues that Examiner has used hindsight, when in fact, this type of testing would be obvious to anyone skilled in the art or marketing research regardless of Appellant's specification. If testing is conducted on knowledge of an advertisement, and specifically a product, also testing such items as product benefits and brand name would simply be a logical extension of such testing.

**Response to Appellants arguments of the 103 rejection over claims 64-66 and 68-70.**

Appellant argues "the material printed on the statistical report has a functional relationship to the statistical report itself and to the method of generating the statistical report". The claim language of these contested claims reads "wherein the statistical report will illustrate". This specific information in the statistical report is never used for any sort of further analysis in any other claim language. These claims simply set forth the type of information conveyed in the report. For example, the method would be performed exactly the same between claims 64 and 65 other than printing information A on the report as opposed to information B. The illustrated information is simply non-functional descriptive material.

**Response to Appellants arguments of the 103 rejection over claims 38-41 and 43.**

Appellant argues "claims 38-41 and 43 includes limitations requiring the selection of a next interactive advertising message based upon the feedback received from the consumer".

Appellant then continues to argue that since McIntyre does not contact the advertiser, this combination is not feasible. Appellant's arguments of the alleged "teaching away" of McIntyre have already been addressed above, and Examiner does not see anything further in these

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dependent claims about contacting an advertiser. Examiner has not found reviewed the arguments and has not found any arguments for these claims that have not already been addressed in the above paragraphs of this Examiner's Answer.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

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amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Michael Bekerman/MB/  
Examiner, Art Unit 3622

Eric Stamber/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622

Conferees:

Eric Stamber/E. W. S./  
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /VM/  
Appeals practice Specialist



**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**



WYNN W. COGGINS  
TECHNOLOGY CENTER DIRECTOR